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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/509,641

09/29/2004

Christian Drohmann

53383

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05/17/2006

NOVAK DRUCE DELUCA & QUIGG, LLP
1300 EYE STREET NW
SUITE 400 EAST TOWER
WASHINGTON, DC 20005

EXAMINER

POPOVICS, ROBERT J

ART UNIT

PAPER NUMBER

1724

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/509,641	DROHMANN ET AL.	
	Examiner	Art Unit	
	Robert J. Popovics	1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Independent claim 11 now specifies a **“constant flow rate.”** Footnote no. 4 in paragraph [0066] of the PG Pub states, ⁽⁴⁾ **“The measured value is constant during the entire filtration period.”** Based only on footnote 4, one would assume that Applicant has successfully challenged at least one of the laws of thermodynamics – conservation of energy, for flow through an empty conduit would have a pressure drop associated with it due to friction loss. However, paragraph [0048] is noted:

[0048] For the purposes of the invention, filtration is passing a suspension (slurry) consisting of a discontinuous phase (dispersed substances) and a continuous phase (dispersion medium) through a porous filter medium. During this operation, solids particles are deposited on the filter medium and the filtered liquid (filtrate) leaves the filter medium in a clear state. An applied pressure difference acts here as an external force to overcome the resistance to flow.

Applicant has failed to teach those skilled in the art how to maintain a constant flowrate. Accordingly, the specification is not seen to be enabling for such.

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Claim Rejections - 35 USC § 102

Claims **15-23** are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Van Den Eynde (US 6,117,459)**.

Van Den Eynde discloses:

In one preferred embodiment of the invention, the filtration adjuvants of the invention comprise incompressible synthetic or natural polymer grains or incompressible natural grains made from, for example, polyamide, polyvinylchloride, fluorinated products such as TEFLON.RTM., polypropylene, polystyrene, polyethylene, certain derivatives of silica, for example ryolites or glass, and mixtures thereof.

In one preferred embodiment of the invention, the process further includes a stabilization step. This step can be carried out during or after the filtration step proper, using filtration adjuvants conventionally employed, including silica gels, gallic tannins, etc. If the stabilization is carried out after the filtration, proteolytic enzymes and polyvinylpyrrolidone (PVPP) are generally used, preferably in a form that can be regenerated.

When the filtration process of the invention includes a stabilization step, the regeneration of the filtration adjuvant also regenerates the stabilizing agent, for example the PVPP.

Also, see claims 8, 11 and 12 of Van Den Eynde. In view of the Van Den Eynde disclosure, the claims are seen to be anticipated. Alternatively, it is submitted that the claimed composition and method of use would have been obvious in view of the teachings of Van Den Eynde.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **11-23** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **1** and **3-16** of copending Application No. **10/398,179** in view of **Van Den Eynde (US 6,117,459)**. Claims **1** and **3-16** specify polystyrene as the first component. **Van Den Eynde** discloses polystyrene and the presently claimed compounds to be functional equivalents (again, see claims 8, 11 and 12 of **Van Den Eynde**). Accordingly, their interchangeable use would have been obvious.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

Applicant's arguments filed **March 6, 2006** have been fully considered but they are not persuasive. Regarding the art rejection, Applicant's only argument is:

US 6,117,459 fails to disclose or suggest filtering and/or stabilizing an aqueous liquid comprising the step of passing a suspension consisting of a discontinuous phase and a continuous phase through a porous filter medium at a constant flow rate as recited in the instant Claims.

This argument is not commensurate in scope with claims **16-23**.

As for the double patenting rejection, Applicant's "***picking and choosing***" argument is noted, but not found to be persuasive. Not only has Van Den Eynde disclosed the functional equivalence asserted, but he has claimed it – see claim 8:

8. Regeneration method according to claim 4 characterized in that the synthetic polymer grains are made from the group consisting of polyamide, polyvinylchloride, fluorinated products, polypropylene, polystyrene, polyethylene, derivatives of silica, ryolites or glass, and mixtures thereof.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Robert J. Popovics at telephone number (571) 272-1164.

A large, stylized handwritten signature in black ink, appearing to read 'RJP', with a horizontal line and a small mark below it.

Robert James Popovics
Primary Examiner
Art Unit 1724

May 15, 2006